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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/439,343 | 11/15/1999 | ANDREW L. DIRIENZO | 236.003US02 | 1539 |
| 27073 | 7590 | 05/15/2006 | EXAMINER | |
| LEFFERT JAY & POLGLAZE, P.A. P.O. BOX 581009 MINNEAPOLIS, MN 55458-1009 | | | RIMELL, SAMUEL G | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2164 | |

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/439,343 | DIRIENZO, ANDREW L. |
| | Examiner | Art Unit |
| | Sam Rimell | 2164 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,9,10,29-32,35,39-44,48-64,70-93,103-113 and 125-127 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-3,9,10,29-32,35,39-44,48-64,70-93,103-113 and 125-127 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: ____ . |

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 9, 10, 29-31, 35, 39-44, 48-58, 60-64, 70-76, 79-87, 89-93, 103-104, 106-111, 113, 125 and 127 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverman et al. (U.S. Patent 5,136,501).

Claim 1: Column 2, lines 17-21 refers to a database of trading instruments available for trade between first and second users. These trading instruments are digital information blocks stored in buffer memory. Each of the digital information blocks includes an indicia of priority, which is either a bid or an offer (See FIG. 4). The digital information blocks are traded between first and second users (client keystations, 24a, 24b). As seen in FIG. 5, a client keystone book only receives and displays a selected number of blocks, in comparison to the central book of FIGH. 4 which receives and displays all the blocks. The establishment of a keystone book (FIG. 5)for a client is thus an election to receive certain information blocks and the selected blocks are those which are displayed. At least block is displayed, so at least one block is selected.

Claim 3: As seen in FIG. 16, users can change the indicia by canceling the indicia. A user can also change the indicia by making multiple offers of multiple bids.

Claim 9: The indicia may be an ask price (FIG. 4).

Claim 10: The ask price is suggested by one of the users. It is not generated automatically.

Claim 29: Silverman et al. discloses a first computer system (one of the keystation books of FIG. 5); a second computer system (central station book of FIG. 4) and a third computer system (one of the keystation books of FIG. 5). Each of the computer systems include memory and operating instructions and are linked together by communications channels. Each of the computer systems receives work order packages, which are the blocks, such as 73-77 illustrated in FIG. 4. Each work order package includes a work order summary (value for the package, such as "138.86" in block 73) and work order (primary quantity for the package, such as "5.0" in block 73). When a bid or offer is placed by one of the bidding or offering parties, the blocks show the data for the work order and work order summary as being parsed (separated within the block). The order of the packages shown on any of the computer terminals is based upon the value of the work order summary. If the work order summary value is, for example, "140.05" (block 100 in Fig. 4), it is the highest value and appears at the highest level in the hierarchical order displayed by the computer terminals. Any change in these indicia would result in a re-ordering of the blocks. Work orders can be singled out at the client keystation book of FIG. 5, where only a subset of blocks are displayed in comparison to the central keystation book which displays all the blocks. At least one block is shown in Fig. 5.

Claim 30: Communications channels link each of the three computer systems together. Any given communications channel can be arbitrarily designated as "low speed" or "high speed" since the claims do not indicate what parameters distinguish the "low speed" from "high speed".

Claim 31: Each of the electronic books illustrated in FIGS. 4 or 5 can be read as “memory queues”.

Claim 35: See remarks for claim 29. Note that the system of Silverman et al. facilitates interactive bidding between multiple parties and functions as an electronic marketplace for the distribution of data to multiple parties.

Claim 39: The digital information blocks are trading instruments in a database (col. 2, lines 17-21). The digital information blocks are ordered within a database. The blocks may be represented by graphic indicators (any of the boxes, lines or indicia in FIG. 4). The indicia of priority is the bid or offer (ask) price. As seen in FIG. 5, client keystation will selectively display only a subset of the blocks, thus selectively single out for receipt only certain blocks derived from master keystation book of FIG. 4.

Claims 40-41: The indicia of priority is the bid or offer (ask) price.

Claim 42: The graphic indicators include both numbers and letters.

Claim 43: FIG. 4 illustrates statistical measures, such as blocks for best offer value and best bid. Value.

Claim 44: The statistical measures are represented graphically, by a graphical user interface.

Claim 48: As seen by comparing FIGS 4-5, the statistical information (best offer value and best bid value) is displayed at only the central station, and thus is presented to only one of the users.

Claim 49: The total number of users may inherently be represented by the total number of blocks when all the users are bidding.

Claim 50: In FIG. 4, each block represents a displayed transaction.

Claim 51: IN FIG. 16, original offers that are cancelled are represented as large hash marks.

Claim 52: As seen in FIG. 4, the indicia are ordered into separate queues. Indicia representing bids are on the left queue. Indicia representing offers are on the right queue.

Claim 53: The graphic indicators in FIG. 4 are ordered according to the time they were received (see right and left pointing arrows at top).

Claim 54: The graphic indicators in FIG. 4 are further ordered according to additional information, namely, the absolute value of price.

Claim 55: The graphic indicators (boxes) are considered to be “links” since they derive from data within a database, and are linked to the data within the database.

Claim 56: FIG. 17 illustrates highlighted graphical indicators (boxes containing “139.19”).

Claim 57: Each user has a graphical user interface that is fully visible to that user. Each graphical user interface can present information that is generated by one of the users.

Claim 58: Any number illustrated in FIG. 4 reads as a document control number.

Claim 60: See remarks for claim 55.

Claim 61: The blocks of FIG. 4 are constantly re-ordered as data is added, or as shown in FIG. 16, re-ordered as data is removed.

Claim 62-63: See remarks for claim 3.

Claim 64: See remarks for claim 55.

Claim 70: See remarks for claim 39. The added phrase “..to thereby permit any buyer to select any offer to sell and any seller to select any offer to buy.” are merely recitations of intended usage for the physical interface and carry no patentable weight. Offers to buy (bids) are singled out by the hit bid process (col. 9, lines 1-10). From another perspective, the bids are singled out by reason that they separated from the offers (FIG. 5) and the offers are singled out by reason that they are separated from the bids (FIG. 5).

Claim 71: See remarks for claims 40-41.

Claim 72: Each graphical indicator includes information extracted from the digital information blocks, namely, the quantity of information blocks being sold for each bid value (see FIG. 4, lower left corner).

Claim 73: See remarks for claims 40-41.

Claim 74: See remarks for claim 43.

Claim 75: See remarks for claim 44.

Claim 76: In FIG. 4, the statistical information is best offer value and best bid value (lower right side). These are bidding and asking prices.

Claim 79: See remarks for claim 49.

Claim 80: See remarks for claim 50.

Claim 81: See remarks for claim 51.

Claim 82: See remarks for claim 52.

Claim 83: See remarks for claim 53.

Claim 84: See remarks for claim 72.

Claim 85: See remarks for claim 55.

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Claim 86: A graphic indicator generated by one user may indicated to that one user, or other users.

Claim 87: See remarks for claim 58.

Claim 89: See remarks for claim 55.

Claim 90: See remarks for claim 61.

Claim 91: See remarks for claim 3.

Claim 92: The digital information block can be removed from auction when it is sold.

Claim 93: See remarks for claim 55.

Claim 103: The digital information block are trading instruments that can be traded between “second” and “third” users, as these are no different than first and second users. The “links” are the blocks illustrated in FIG. 4. The set of links displayed is the link list. The individual links can be singled out by the “hit bid” process (col. 9, lines 1-10).

Claim 104: The digital information blocks are trading instruments, which are electronic files since they are stored in a database (col. 2, lines 17-21). The indicia are bid and ask prices. No patentable weight is attributed to the method steps of following a link or issuing payment.

Claim 106: See remarks for claim 3.

Claims 107-111 and 113: The system may include any number or “N” information blocks or “M” users. The added phrase “..the GUI permitting any of the third users to select any of the N electronic information blocks” is a recitation of intended usage for the storage medium and thus carries no patentable weight.

Claim 125: See remarks for claim 1.

Claim 127: The bids and offers can be overwritten by first removing them (such as by executing a trade, which would remove a bid matched to an offer) and then applying new bids and offers.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 32, 59, 77, 78, 88, 105, 112 and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al.

Claims 2, 105 and 112: Silverman et al. discloses trading instruments stored in a database (col. 2, lines 17-21). In relation to the apparatus, the content of the instrument is not functionally related to the substrate. It merely resides in the substrate for retrieval. In accordance with *In re Gulack* (703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)), when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. Accordingly, the inclusion of medical images as the descriptive material in the trading instrument will not distinguish from the prior art in terms of patentability, and is considered to have been obvious to one of ordinary skill in the art.

Claims 32: Computer access the subsets of data by requiring the user to submit a password is well known in art. It would have been obvious to one of ordinary skill in the art to

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modify Silverman et al. to require password protection of the data, as is well known in the art for the practice of data security.

Claim 77-78: Statistical values, such as the median values described with respect to claim 45, inherently require arithmetic calculations. Claims 77-78 are therefore obvious for the same reasons as those set forth for claim 45, since the performance of calculation of mean values inherently requires the performance of arithmetic calculations.

Claim 126: See remarks for claim 2.

Claims 59 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al. in view of Patterson, Jr. et al. (U.S. Patent 5,915,245).

Claims 59 and 88: Patterson et al. illustrates the usage of file names (IBM in FIG. 1) which are associated with tradable instruments. It would have been obvious to one of ordinary skill in the art to modify Silverman et al. to include file names with each block of graphical data in order to distinguish between different trading instruments, as taught by Patterson, Jr. et al.

Remarks

Applicant's arguments and amendments have been considered.

Amendments to specification: The amendments to the specification are approved for entry and overcome the objections raised in the office action.

Rejections under 35 USC 112, first paragraph: The rejections under 35 USC 112, first paragraph are rendered moot in light of applicant's cancellation of all claims subject to this rejection.

Claims 1, 29, 35, 39, 70: Applicant argues that Silverman et al. does not disclose “a select one of the digital information blocks can be elected for receipt by one of the second users”. While this feature may or may not be demonstrated by the “hit bid” feature, depending upon interpretation, it is still clearly taught by other features of Silverman et al. The creation of the keystation book of FIG. 5 is an election by a client to receive and display a limited subset of blocks from the central keystation book of FIG. 4. Those blocks which are shown in FIG. 5 are the blocks which are selected for display. At least one block is shown, so at least one block is selected for display. It should also be noted that the claim does not state that only one block should be displayed, but rather, that at least one block should be displayed. At least one block is in fact displayed in FIG. 5.

Applicant argues that Silverman et al. does not teach singling out the digital blocks in response to a user election. This argument is not correct. The creation of the client keystation book of FIG. 5 is an election to receive certain blocks. The blocks shown in FIG. 5 are those selected from the central keystation book.

Claims 103, 107, 125: Independent claims 103, 107 and 125 are not amended, and examiner maintains that the “hit bid” process does function to “single out” blocks, since it operates by singling out a bid price that may be embodied by one or more digital blocks. Again, the claims are not addressed to the concept of singling out only one block, but are defined so as to single out at least one block.

Rejections under 35 USC 103: Examiner has not taken Official Notice, so applicant’s arguments are moot with respect to such an issue. Examiner has cited a basis for obviousness based on *In re Gulack*, and applicant has not responded specifically to this finding, aside from a

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generic traverse of the rejection. Applicant's arguments regarding Patterson Jr. et al. are also generic, and not specific to the issues raised.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.



Sam Rimell
Primary Examiner
Art Unit 2164